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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/608,598 | 06/27/2003 | Ben Huang | WINN.001A | 2270 |
| 20995 | 7590 | 11/19/2004 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614 | | | BLAU, STEPHEN LUTHER | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3711 | |

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/608,598 | HUANG, BEN | |
| | Examiner | Art Unit | |
| | Stephen L. Blau | 3711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480.

Pan discloses an antimicrobial grip (abstract) comprising an elastomer (abstract) bonded to a textile layer [0010], an elastomer comprising an inorganic antimicrobial agent (Claim 1), a Derwent abstract having the grip formed of polyurethane (Detailed Description), and an inorganic antimicrobial agent comprising tin (Claim 1).

Pan lacks a grip being an elongated strip and an elastomer being polyurethane. 9-75480 discloses a grip being an elongated strip (Derwent Title) and a resin film of foamed polyurethane on a side of fabric containing an antimicrobial (Derwent Abstract). In view of the reference of 9-75480 it would have been obvious to modify the grip of Pan to have a grip being a tape in order to utilize the advantages of Pan for a grip made from a strip. In view of the reference of 9-75480 it would have been obvious to modify the elastomer of Pan to be a polyurethane in order to utilize an elastomer used in the art in making antimicrobial grips.

It appears that the scanned publication in properly defined PU as plutonium instead of polyurethane.

3. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480 as applied to claims 1-2 and 6 above, and further in view of Huang (5,695,418).

Pan lacks polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape.

Huang (5,695,418) discloses a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape (Fig. 4). In view of the patent of Huang (5,695,418) it would have been obvious to modify the grip of Pan to have a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip, a textile layer being felt, an adhesive layer, and a protective quick-release tape in order to utilize the advantages of Pan with a grip tape of Huang (5,695,418).

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480 as applied to claims 1-2 and 6 above, and further in view of 7-215811.

Pan lacks an antimicrobial metal being silver. 7-215811 discloses treating polyurethane foam with tin or silver to produce antibacterial effects (English Constitution). In view of 7-215811 it would have been obvious to modify the grip of 9-75480 to have an antimicrobial metal being silver in order to utilize an antimicrobial agent available in the market place.

5. Claims 9-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480 and 7-215811 as applied to claims 7-8 above, and further in view of Yasui.

Pan lacks an antimicrobial agent silver ion in a porous based carrier of a silica-alumina carrier and the concentration by weight of an inorganic antimicrobial agent is about 2%. Yasui discloses a urethane material (Col. 2, Lns. 65-67) for a grip (Col. 1, Lns. 21-27) for a fishing pole (fig. 1) having antibacterial and antifungal material (Col. 2, Lns. 61-64) in the form of inorganic material of silver in a porous (Col. 1, Lns. 53-56) silica-alumina (Col. 3, Lns. 8-20), BACTEKIRANI, NOVALON (Table 1) and the concentration by weight of an inorganic antimicrobial agent is from .2 to 3 % (Tables 1-2) in order to cause less skin irritation and offer improved durability (Col. 3, Lns. 8-20). In view of the patent of Yasui it would have been obvious to modify the grip of Pan to have a silver metal in a porous silica-alumina carrier having a concentration by weight of an inorganic antimicrobial agent being about 2% in order to cause less skin irritation and offer improved durability for an elastomer having an antibacterial agent.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of 9-75480, 7-215811 and Yasui as applied to claims 9-11 above, and further in view of applicant's disclosure.

Pan lacks an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12. The applicant admits a commercially available silica-alumina carrier containing silver is montmorillonite having the formula as defined by claim 12 [0027]. In view of applicant's disclosure it would have been obvious to modify the grip of Huang to have an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12 in order to utilize a silica-alumina carrier containing silver as an antimicrobial agent available in the market place.

7. Claims 16, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418) and 7-215811.

Pan lacks a grip being an elongated strip and an elastomer being polyurethane. Huang discloses a grip being an elongated strip (Fig. 1) and layer of polyurethane (Abstract). In view of the reference of Huang it would have been obvious to modify the grip of Pan to have a grip being a tape in order to utilize the advantages of Pan for a grip made from a strip. In view of the reference of Huang it would have been obvious to modify the elastomer of Pan to be a polyurethane in order to utilize an elastomer used in the art in making grips.

See paragraphs above for elements of structure previously rejected by Pan in view of Huang (5,695,418) and 7-215811.

8. Claims 17-18, 20-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan in view of Huang (5,695,418) and 7-215811 as applied to claims 16, 19 and 22 above, and further in view of Yasui and applicant's disclosure.

See paragraphs above for elements of structure previously rejected by Pan in view of Yasui and applicant's disclosure.

Response to Arguments

9. The argument that Haseyama contained a different manufacturing process to make an elastomer is agreed with. As such a new grounds of rejection has been made and the action is not made final. The argument that it would be improper to include the additive of Yasui with a grip of Huang due to the different process of Yasui and Huang is disagreed with. New reference of Pan and 7-215811 discloses adding metal additives to elastomers in a similar process as applicant's process. Yasui discloses an additive which would provided the same benefit also to the processes of Pan and 7-215811. The argument that it is improper to use applicant's disclosure of montmorillonite since it is taking the applicant's teaching or suggestion in the disclosure to show a combination and not a teaching or suggestion in the prior art is disagreed with. The examiner used to reference of Yasui to show the teaching that it is desirable to place a silver metal in a carrier of silica-alumina. Clearly any suitable silica-alumina carrier commercially

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available in the market place would be an obvious selection in which the disclosed silica-alumina by the applicant is included.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415.

slb/ 16 November 2004


STEPHEN BLAU
PRIMARY EXAMINER